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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TRAN, PHILIP B	

ART UNIT	PAPER NUMBER
2155	13

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/376,880	WU ET AL.	
	Examiner	Art Unit	
	Philip B Tran	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Response to Request for Reconsideration

1. This office action is in response to the Request for Reconsideration filed on 9/4/2003. Therefore, pending claims 1-33 are presented for further examination.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6, 10-15 and 19-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Raman, U.S. Pat. No. 6,134,598 in view of Klein et al (Hereafter, Klein), U.S. Pat. No. 6,178,426.

Regarding claim 1, Raman teaches a method of accessing data at a server computer from a client computer connected via a network, the data being stored on a

data storage device connected to the server computer, the method comprising the steps of at the server computer, receiving a request for data from the client computer, determining whether the client computer can access the data in its stored form, when it is determined that the client computer cannot access the data in its stored form, converting the data into a form that the client computer can access (i.e., receiving a request for data from the client; identifying which resources on the client can perform the function and identifying a set of data formats upon which the resources can perform the function of displaying, printing or editing; translating data from the first format to one of the set of data formats performable by the client; using the resource on the client to perform the function on the parsed data in the second data format) [see Abstract, Col. 1, Line 10 - Col. 2, Line 62, and Col. 3, Line 15-37]. Raman does not explicitly teach returning a locator to the client computer for locating the data. However, Klein teaches returning the URL to the client for the client to retrieve requested data from appropriate location [see Col. 10, Lines 45-65]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Raman and Klein teachings because it would have improved a load on the server by returning the locator to the client for the client locating the stored data in other storage such as database and thereby decreased the number of steps of delivering data via the server which in turn will reduce the total traffics in the network.

Regarding claim 2, Raman further teaches the step of receiving a request further comprises the step of receiving a URL command (i.e., the request message includes URL) [see Col. 1, Lines 20-21 and Col. 2, Lines 34-36].

Regarding claim 3, Raman further teaches the URL command specifies a file identifier for a file containing the data and a file format for the file (i.e., location of data file including data and format) [see Col. 1, Lines 20-23 and Col. 2, Lines 34-39].

Regarding claim 4, Raman further teaches before the step of retrieving the file, further comprising the step of determining whether the file identifier is valid [see Col. 5, Lines 18-36].

Regarding claim 5, Raman further teaches the step of determining further comprises the step of comparing the file format specified by the URL command to a file extension of the stored file [see Fig. 6 and Col. 6, Lines 1-11].

Regarding claim 6, Raman further teaches the step of converting further comprises the step of converting the retrieved file to the file format specified by the URL command [see Abstract and Col. 3, Lines 14-38].

Claims 10-15 and 19-24 are rejected under the same rationale set forth above to claims 1-6, respectively.

4. Claims 7-9, 16-18, 25-27 and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Raman, U.S. Pat. No. 6,134,598 in view of Klein et al (Hereafter, Klein), U.S. Pat. No. 6,178,426 and further in view of Guck, U.S. Pat. No. 5,911,776.

Regarding claims 7-9, Raman teaches converting data from one format to another format usable by the client but Raman and Klein do not explicitly teach generating a path name to locate the converted data stored on the server, wherein the locator comprises the path name, and wherein the client computer has a Web browser and under control of the Web browser, retrieving the converted data from the server computer using the generated path name. However, Guck teaches data files are stored in the database with locator identifying path name [see Figs. 1 & 8 and Col. 10, Lines 22-46]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to generate a path name for every file in order to efficiently organize files in the storage for easy access and retrieval by the client.

Claims 16-18 and 25-27 are rejected under the same rationale set forth above to claims 7-9, respectively.

Claims 31-33 are rejected under the same rationale set forth above to claims 7-9.

5. Claims 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Raman, U.S. Pat. No. 6,134,598 in view of Klein et al (Hereafter, Klein), U.S. Pat. No.

6,178,426 and further in view of Guck, U.S. Pat. No. 5,911,776 and further in view of Beckwith et al (Hereafter, Beckwith), U.S. Pat. No. 6,330,598.

Regarding claims 28-30, Raman and Klein do not explicitly teach deleting the stored converted data after a predetermined period of time. However, the concept of deleting stored data within a period of time is old and well-known in the art as disclosed by Beckwith [see Col. 19, Lines 26-36]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to regularly update storage and delete old stored data in order to save memory spaces for storing other needed data.

Response to Arguments

6. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons :

Raman teaches a method of accessing data at a server computer from a client computer connected via a network, the data being stored on a data storage device connected to the server computer, the method comprising the steps of at the server computer, receiving a request for data from the client computer, determining whether the client computer can access the data in its stored form, when it is determined that the client computer cannot access the data in its stored form, converting the data into a form that the client computer can access. For example, receiving a request for data from the client, identifying which resources on the client can perform the function and identifying a set of data formats upon which the resources can perform the function of displaying, printing or editing; translating data from the first format to one of the set of data formats performable by the client, and using the resource on the client to perform

the function on the parsed data in the second data format [see Abstract, Col. 1, Line 10 - Col. 2, Line 62, and Col. 3, Line 15-37]. Raman does not explicitly teach returning a locator to the client computer for locating the data. However, Klein teaches returning the URL to the client for the client to retrieve requested data from appropriate location [see Col. 10, Lines 45-65]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Raman and Klein teachings because it would have improved a load on the server by returning the locator to the client for the client locating the stored data in other storage such as database and thereby decreased the number of steps of delivering data via the server which in turn will reduce the total traffics in the network.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See ***In re Keller*, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck* & Co., 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986)**. Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown above. *In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references.* See **In re Nomiya, 184 USPQ 607 (CCPA 1975).** *However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the*

combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. See **In re McLaughlin, 170 USPQ 209 (CCPA 1971).** *References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.* See **In re Bozek, 163 USPQ 545 (CCPA) 1969.** *Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.* See **In re Bode, 193 USPQ 12 (CCPA 1977)**. In this case, the reason for combining reference Raman and Klein is that to improve a load on the server by returning the locator to the client for the client locating the stored data in other storage such as database and thereby decrease the number of steps of delivering data via the server which in turn will reduce the total traffics in the network.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See ***In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).**

Per applicant's request, examiner provides reference to support for the basis of rejections of claims 28-30. The concept of deleting stored data within a period of time is

old and well-known in the art as disclosed by Beckwith [see Col. 19, Lines 26-36]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to regularly update storage and delete old stored data in order to save memory spaces for storing other needed data.

Therefore, the examiner asserts that the cited prior arts teach or suggest the subject matter broadly recited in independent claims. Claims 2-9, 11-18 and 20-33 are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, rejections for claims 1-33 are respectfully maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PBT

Philip Tran
Art Unit 2155
Nov 13, 2003

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER